

### **REMARKS**

Claims 1-30, 41-45 and 47-59 are currently pending in the application. Claims 1-30, 43 and 44 have been withdrawn pursuant to the Office's previous Restriction Requirement. Claims 31-40 and 46 were previously canceled. Claims 49, 54 and 57-59 are canceled in the present reply, and claims 41, 45, 47, 48, 50, 51, 55 and 56 are currently amended. These claims have been canceled or amended without prejudice to, or disclaimer of, the subject matter thereof. Applicants reserve the right to file continuing applications directed to the subject matter of any claim canceled or amended for any reason.

The amendments to claims 41, 45, 47, 48, 50, 51, 55 and 56 place the application in better condition for examination. It is submitted that no new matter has been introduced by these amendments with support found throughout the specification as filed. By these amendments, Applicants do not acquiesce to the propriety of the Office's rejections and do not disclaim any subject matter to which Applicants are entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 USPQ.2d 1865 (US 1997).

#### **I. Claim Objections**

The Office states that in the elected group  $R^2$  is H and  $R^3$  is an aryl but that the claims as pending recite a different scope. February 19, 2009 Office Action ("OA"), page 3. Applicants have amended the claims to recite that  $R^2$  is H and  $R^3$  is aryl or aryl alkylene, the elected subject matter of Group IIIa (see OA, page 2).

Accordingly, Applicants request that the Examiner reconsider and withdraw this objection.

The Office also objects to claim 59 carrying over to the Remarks. Claim 59 is canceled in the current reply and all pending claims are on a sheet separate from the Remarks.

Accordingly, Applicants request that the Examiner reconsider and withdraw this objection.

## **II. Claim Rejections**

### **A. 35 U.S.C. § 112, first paragraph**

Claims 41, 42, 45 and 47-59 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly not enabled by the specification. OA, page 14. Applicants respectfully disagree.

The Office takes the position that there are "numerous types of inflammation" (OA, page 6) and that the "permutations and combinations [of the claimed molecules] are in the zillions." OA, page 5. Applicants have reviewed the case law and references cited by the Office in support of the assertion that the previously pending claims lacked enablement. Applicants do not agree with these assertions and positions. Nonetheless, and solely to expedite prosecution, Applicants have amended the claims to recite inflammation mediated at least in part by IL-8 or GRO- $\alpha$  and an  $R^1$  group selected from  $R^5$  and  $R^5$ -SO<sub>2</sub>, where  $R^5$  is selected from hydrogen, halogen, alkyl, heteroalkyl, aryl, heteroaryl, amino or hydroxyl. These amendments further define the types of inflammation encompassed and the possible groups of claimed compounds such that Applicants submit that the alleged unpredictability of the art is addressed.

Based on the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the pending rejections of claims 41, 42, 45 and 47, 48, 51-53, 55 and 56 under 35 U.S.C. § 112, first paragraph. If the Examiner does not withdraw these Amendments, Applicants respectfully remind the Examiner that under the principles of compact prosecution, the Examiner should look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application. MPEP § 2164.04.

### **B. 35 U.S.C. § 112, second paragraph**

Claim 56 stands rejected under 35 U.S.C. § 112, second paragraph as incomplete for omitting the definition of  $R^1$ . Claim 56 has been amended to recited that  $R_1$  is selected from (C<sub>1-6</sub>alkyl)SO<sub>2</sub>, PhSO<sub>2</sub>, fluorinatedphenylSO<sub>2</sub>, PhCH<sub>2</sub>SO<sub>2</sub>, cyclopentylSO<sub>2</sub>, *m*-carboxyphenylSO<sub>2</sub>, *m*-methylphenylSO<sub>2</sub>, and HOOC-(C<sub>1</sub>-C<sub>4</sub>alkylene)SO<sub>2</sub>.

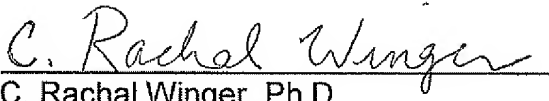
Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the pending rejection of claim 56 under 35 U.S.C. § 112, second paragraph.

**CONCLUSION**

Applicants have properly and fully addressed each of the Examiner's grounds for rejection. Applicants submit that the present application is now in condition for allowance. If the Examiner has any questions or believes further discussion will aid examination and advance prosecution of the application, a telephone call to the undersigned is invited. If there are any additional fees due in connection with the filing of this amendment, please charge the fees to undersigned's Deposit Account No. 503207. If any extensions or fees are not accounted for, such extension is requested and the associated fee should be charged to our deposit account.

Respectfully Submitted,

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C. Rachal Winger, Ph.D.  
Registration No. 55,815  
CUSTOMER NUMBER: 85,943

**K&L GATES LLP**  
925 Fourth Avenue, Suite 2900  
Seattle, WA 98104  
Telephone: (206) 370-6641  
Email: ocipgroup@klgates.com

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